REMARKS

The outstanding issues are as follows:

- The Title of the invention is objected to as being non-descriptive;
- Claims 1-3, 5-13, 17-21, 23-28, 30-36, 40-42, and 44-46 are rejected under 35 U.S.C. § 103(a); and
- Claims 4, 14-16, 22, 29, 37-39, and 43 are objected to as being allowable subject matter, but depending from non-allowable independent claims.

I. OBJECTION TO THE SPECIFICATION

Applicant has amended the Title to, "BANDWIDTH MANAGEMENT IN A WIRELESS MEASUREMENT SYSTEM USING STATISTICAL PROCESSING OF MEASUREMENT DATA." Support for this amendment can be found in the claims, as originally filed, and throughout the Specification. No new matter was added.

Applicant believes that the new title adequately and specifically describes the nature of the invention as required by 37 CFR § 1.72(a). Therefore, Applicant respectfully requests the Examiner to accept the new title and withdraw his objection of record.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

As noted in Applicants' previous responses, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the Examiner's continued rejections do not satisfy these criteria.

A. No Motivation To Combine

In response to Applicant's arguments in the Response dated March 14, 2006, the Examiner makes statements that emphasize either the improper combination of *Thornton*

with *Laguer-Diaz* or the Examiner's misunderstanding of Applicant's argument. The Examiner began his response by stating, "Applicant argues that Thornton and Laguer-Diaz collect performance data differently, the Examiner agrees." This statement leads Applicant to believe that the Examiner has misunderstood Applicant's arguments. Applicant has not, in fact, argued that *Thornton* and *Laguer-Diaz* collect performance data differently. The type of data or the collection method of the data in *Thornton* and *Laguer-Diaz* is largely irrelevant. As the Examiner later points out, both *Thornton* and *Laguer-Diaz* describe collecting some kind of performance data and then wirelessly sending that data to a remote monitoring center. April 20, 2006, Office Action, p. 2. However, the Examiner then concludes that Applicant's argument concerning *Thornton*'s explicit teaching away from *Laguer-Diaz* is irrelevant because "Thornton is referring to colleting and transmitting performance data of a wireless communication system and Laguer-Diaz is related to collecting and transmitting internal diagnostics data of a vehicle." April 20, 2006 Office Action, p. 2. Thus, the Examiner finds that one of the underlying differences in the teachings of *Thornton* and *Laguer-Diaz* makes Applicant's argument that *Thornton* explicitly teaches away from the combination irrelevant. This statement actually does not make sense in response to Applicant's "teaching away" argument.

As noted above, the Examiner later attempts to rehabilitate his statement regarding the differences between *Thornton* and *Laguer-Diaz* by stating that they both teach collecting and wirelessly sending performance data to a remote monitoring center and thus are in related technology. April 20, 2006 Office Action, p. 2. These statements from the Examiner are contradictory. One the one hand, the Examiner finds that the references are so different that Applicant's argument that they should not be combined is irrelevant, yet he also finds that the references teach the same basic concept so he is free to combine their teachings.

The fact remains that *Thornton*, which is the reference dealing with performance data in a wireless communication system, ***explicitly*** criticizes, discredits, and discourages the very element from *Laguer-Diaz* that the Examiner has combined with *Thornton*. *Thornton* states:

> The traditional approach to identifying locations with poor network RF coverage is to perform drive testing to determine wireless network RF coverage issues. Drive testing involves engineers driving in automobiles

> in wireless network coverage areas with radio equipment used for testing RF coverage. ***This process is expensive, slow, and very labor-intensive.*** Para. [0002] (emphasis added).

Thornton is, thus, criticizing testing from a moving vehicle. *Thornton* summarizes its invention stating, "The received information is a collection of the wireless device performance history and ***does not require costly, time-consuming drive testing or customer involvement.***" Para. [0008] (emphasis added). As the Examiner admits, *Laguer-Diaz* relates to collecting and wirelessly sending performance data to a remote monitoring center. *Laguer-Diaz*, Abstract. Thus, *Laguer-Diaz* relates to mobile testing which *Thornton* ***explicitly*** teaches is undesirable and is ***no longer required*** through implementation of its invention. The Examiner's dismissal of Applicant's argument based on the different way in which *Thornton* and *Laguer-Diaz* collect data is simply nonsensical.

The Examiner attempts to further bolster his improper combination by stating, "In any event, the Examiner is only using the Laguer-Diaz reference to show a teaching of sending statistical data rather than raw data." April 20, 2006 Office Action, p. 2. However, this statement also shows that the Examiner is improperly combining references. It is well settled that, when considering prior art references, the Examiner must consider the reference in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc., v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Examiner cannot escape the teachings of the references that teach away from each other simply by cobbling together bits and pieces of various references.

If the Examiner is to consider combining *Thornton* and *Laguer-Diaz*, he must consider both references ***as a whole***, including the portions that teach away from each other. In that case, there is no motivation to combine *Thornton* and *Laguer-Diaz* because *Thornton* specifically teaches away from drive testing or testing from a moving test platform. When considering whether a reference teaches away from a particular element, the courts find that the teachings that actually criticize, discredit, or otherwise discourage the element clearly teach away from that element. *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004). Here, as noted above, *Thornton* actually criticizes drive testing or testing from a moving test platform.

Therefore, there can be no doubt from the Examiner that *Thornton* should not be combined with any reference that teaches drive testing or testing from a moving test platform.

The Examiner relies on their improper combination of *Thornton* with *Laguer-Diaz* to support each of his rejections of claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46. None of the other references cited to by the Examiner provide the same limitations as those relied on from *Laguer-Diaz*. Therefore, without *Laguer-Diaz*, the Examiner's rejections must fail. Applicants, thus, assert that each of claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46 are patentable over the 35 U.S.C. § 103(a) rejection of record.

B. Does Not Teach or Suggest All Claim Limitations

Claims 1–3, 5–7, 9, 10, 12, 25–28, 30, 31, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz*.

1. Claims 1–3, 5–7, 9, 10, and 12

In response to Applicant's arguments in the Response dated March 14, 2006, the Examiner clarifies that the claim term "an indicator ... to begin taking measurements of one or more variables" is taught by "when a neighbor cell measurement is scheduled" from paragraph [0038] of *Thornton*. The Examiner is thanked for the clarification of his position. However, Applicant still disagrees.

Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." While *Thornton* discloses a scheduled cell measurement, a scheduled cell measurement does not, in fact, teach or suggest that an indicator is received at the wireless probe signaling the wireless probe to begin taking measurements. Even beyond the argument of whether a scheduled activity can equate to a signal for beginning that activity, *Thornton* does not teach that the scheduling is received at the mobile device or controller. The fact that a signal to begin may or may not exist in *Thornton* does not cure the fact that there is no teaching that anything that could even loosely be considered that beginning signal is received at the wireless device, as required by claim 1. Therefore, the combination of *Thornton* and *Laguer-Diaz* fails to teach each and every

limitation of claim 1. Applicants, thus, assert that claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2–3, 5–7, 9, 10, and 12 each depend directly or indirectly from independent claim 1 and, thus, inherit each of the limitations of clam 1. As such, claims 2–3, 5–7, 9, 10, and 12 are each patentable over the asserted combination of references. Applicants, thus, assert that claims 1–3, 5–7, 9, 10, and 12 are patentable over the § 103(a) rejection of record and respectfully request the Examiner to withdraw same.

2. Claims 25–28, 30, 31, and 33

In response to Applicant's arguments in the Response dated March 14, 2006, the Examiner states that *Laguer-Diaz* teaches "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification," as required in claim 25. The Examiner equates the end of the day to a transition event notification. Therefore, when *Laguer-Diaz* states, "because of the significant volume of the daily download data, in one embodiment, statistical measures are calculated and transmitted to the remote site 18, in lieu of transmitting raw data," the Examiner finds that this embodiment meets the requirement of claim 25. However, this selection from *Laguer-Diaz* does not teach that the statistical data is calculated responsive to receiving a transition event notification. *Laguer-Diaz* is silent with regard to when the statistical measures are calculated. Claim 25 requires the calculating to be done responsive to receiving a transition event notification. Even if the end of the day could be considered a transition event notification, which Applicant's do not agree with, in order to meet the claim limitations, the statistical measures would have to be calculated upon receipt of this notification, which *Laguer-Diaz* does not teach or even suggest. As such, Applicants assert that claim 25 is patentable over the § 103(a) rejection of record and respectfully request the Examiner to withdraw same.

Claims 26–28, 30, 31, and 33 each depend directly or indirectly from independent claim 25 and, thus, inherit each of the limitations of clam 25. As such, claims –28, 30, 31, and 33 are each patentable over the asserted combination of references. Applicants, thus,

assert that claims 25–28, 30, 31, and 33 are patentable over the § 103(a) rejection of record and respectfully request the Examiner to withdraw same.

3. Claims 8 and 32

Claims 8 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 6,401,054 to Anderson, (hereinafter *Anderson*). Claim 8 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 8, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claim 32 depends from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants therefore assert that claim 32, through its dependence from independent claim 25, is patentable over the 35 U.S.C. § 103(a) of record.

4. Claims 11 and 34

Claims 11 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 5,805,200 to Counselman, III, (hereinafter *Counselman*). Claim 11 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Counselman.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Counselman* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 11, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claim 34 depends from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants therefore assert that claim 34, through its dependence from independent claim 25, is patentable over the 35 U.S.C. § 103(a) of record.

5. Claims 13, 35, and 36

Claims 13, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 5,987,306 to Nilsen, et al., (hereinafter *Nilsen*). Claim 13 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one

or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Nilsen.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Nilsen* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 13, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claims 35 and 36 each depend from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants therefore assert that claims 35 and 36, through their dependence from independent claim 25, are patentable over the 35 U.S.C. § 103(a) of record.

III. ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for indicating that claims 4, 14-16, 22, 29, 37-39, and 43 would be allowable if rewritten in independent form. However, Applicants believe that, based on the improper combination of *Laguer-Diaz*, the claims are currently allowable in present form.

IV. CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. The fee required for the Request for Continued Examination is dealt with in the accompanying transmittal. If any additional fees are due, please charge Deposit Account No. 50-1078, under Order No. 10031298-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568257842US, in an envelope addressed to: MS RCE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: June 19, 2006

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